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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,638	01/23/2004	Shridhar P. Joshi	47079-00225USP1	7736
70243	7590	10/03/2007	EXAMINER	
NIXON PEABODY LLP			HYLINSKI, STEVEN J	
161 N CLARK ST.			ART UNIT	
48TH FLOOR			PAPER NUMBER	
CHICAGO, IL 60601-3213			3714	
			MAIL DATE	DELIVERY MODE
			10/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,638

Applicant(s)

JOSHI ET AL.

Examiner

Steven J. Hylinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/29/2007
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :04/26/2004, 05/27/2004, 12/06/2004, 02/25/2005.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-2, 4-5, 7, 12-15, 17-18, 28-29, 32, and 34 are rejected under 35**

U.S.C. 102(b) as being anticipated by USPN 6,155,925 to Giobbi et al. (Giobbi).

Re Claim 1,

Giobbi discloses a method for playing a wagering game having a special payout (Abstract), the method comprising: presenting a basic game having a plurality of randomly selected outcomes including a special-payout outcome (2: 39-47); presenting a side-wager option for a player (8: 6-15, Also Figs. 8a-d, the player can wager a minimum of one credit, and also additional credits up to a total of 25 credits, including using a "MAX BET" button 32 shown in Fig. 1 to choose the maximum side wager); in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special- payout outcome (8: 27-29, also Figs. 8a-e, the winning bonus game outcomes are available no matter how large or small the player's wager is); in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability (Abstract, also 8: 27-64, and Figs. 8a-e, the probability of achieving the winning bonus game outcomes

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increases as the player's wager increases); conducting the basic game with the first probability or the second probability, depending on the player's choice on the side-wager option (4: 48-59, the player chooses a wager amount and the basic game is conducted according to the pay schedule, 5:52-63, a start bonus outcome occurring in the basic game triggers a bonus game, and Figs. 8a-e show that the bonus game will be conducted with varying probabilities for winning the special bonus payout, depending on the wager made at the beginning of the basic game) ; and in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game (5: 52-63, a start bonus outcome may occur from a basic game, Fig. 7, the player is paid for the winnings from the basic game, plus winnings from the bonus game, Figs. 8a-e show how much a player is paid for certain winning bonus game outcomes).

Re Claim 2,

Giobbi discloses a method further comprising crediting the player a second and third payout when, respectively, a second and third randomly selected outcome occurs in the basic game (Figs. 3-4 show all of the possible payouts based on the randomly selected outcomes occurring on the reels).

Re Claims 4 and 31,

Giobbi discloses a method and gaming terminal wherein the special payout is a bonus game (5:52-64, a predetermined outcome in the basic game triggers a bonus game, having special payouts shown in Figs. 8a-e).

Re Claims 5, 7, 17-18, 32, and 34

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Giobbi discloses a method and gaming terminal wherein the plurality of randomly selected outcomes are indicated by a slot machine and each of the plurality of symbols is a reel symbol (4:59-67 and Fig. 1, the outcomes are indicated by slot machine reels 14).

Re Claim 12,

Giobbi discloses a gaming terminal for playing a wagering game having a special payout with a first payout and a second payout (Fig. 8a-e show the plurality of payouts that can occur during a bonus win), the gaming terminal comprising a basic game having a randomly selected outcome (Figs. 3-4), the gaming terminal having two options for being eligible for the special payout, the two options including (i) a side-wager input option (3:60-62, any wager amount in addition to the minimum required wager constitutes a side wager) and (ii) a max-wager option (3: 60-62, the player can select a maximum wager amount), whereby, in response to selection of one of the two options, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved in the basic game and the gaming terminal awards the player the second payout when a second randomly selected outcome is achieved in the basic game (4:48-58 and Figs 3-4).

Re Claim 13,

Giobbi discloses a gaming terminal wherein the special payout is one of a progressive jackpot and a bonus game jackpot (8: 6-15, bonus game payout).

Re Claim 14,

Giobbi discloses a gaming terminal wherein the max-wager option comprises wagering the maximum amount on all of a plurality of paylines (3:59-67).

Re Claim 15,

Giobbi discloses a gaming terminal wherein the side-wager option is a button or a key (4: 41-44, also Fig. 1, MAX BET button **32**).

Re Claim 28,

Giobbi discloses a method for playing a wagering game having a special payout, the method comprising: conducting a basic game having a plurality of randomly selected outcomes (2: 39-47); presenting a side-wager option for a player to be eligible for the special payout (8: 6-15, Also Figs. 8a-d, the player can wager a minimum of one credit, and also additional credits up to a total of 25 credits, including using a "MAX BET" button **32** shown in Fig. 1 to choose the maximum side wager); presenting a maximum number of paylines and a maximum wager for each payline (Fig. 1, "MAX BET" button **32** selects the maximum number of paylines and maximum corresponding wagers, also as-described in 3: 59-67); and in response to the player selecting the side-wager option or choosing the maximum number of paylines and placing the maximum wager for each of the paylines, crediting the player the special payout when a special-payout outcome occurs in the basic game (8: 35-39 and Figs. 8a-8e).

Re Claim 29,

Giobbi discloses a gaming terminal for playing a wagering game having a special payout (Abstract and Fig. 1), the gaming terminal comprising: a basic game having a plurality of randomly selected outcomes (Fig. 1, slot reels **14**), including a special-

payout outcome that awards the special payout (4: 12-20, bonus game is triggered from certain reel symbols disclosed in Figs. 3-4); a side-wager input device (Fig. 1, "MAX BET" button 32 causes a wager in excess of the minimum required wager to occur, hence a side-wager); wherein in response to a player not choosing the side-wager input device, the gaming terminal providing the player with a first probability greater than zero of achieving the special payout (8: 27-39, even if the player chooses the minimum wager and no additional wagers, the player still has a chance of achieving a winning bonus outcome); and in response to the player activating the side-wager input device, the gaming terminal providing the player with a second probability of achieving the special-payout outcome, the second probability being higher than the first probability, and the gaming terminal further crediting the player the special payout if the special-payout outcome occurs (8: 35-39 and Figs. 8a-8e).

3. Claims 1-5, 7, 9, 25-27, 31-32, 34, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 7,029,395 to Baerlocher.

Re Claims 1 and 3,

Baerlocher discloses a method for playing a wagering game having a special payout (progressive jackpot, 1: 30-43, 9:61-67, 10:1-15), the method comprising: presenting a basic game having a plurality of randomly selected outcomes including a special-payout outcome (6: 52-56, it is disclosed that the primary game can be slots, and 1: 30-43, 8: 48-67 disclose a jackpot award, which is the special-payout outcome, and 9:61-67, 10:1-15 further disclose that the jackpot payout can be a progressive jackpot payout); presenting a side-wager option for a player (7:4-10, each time the

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player increments the wager beyond the minimum wager, the player is making a side-wager); in response to a player not choosing the side-wager option, providing the player with a first probability greater than zero of achieving the special- payout outcome (9:1-5, 100,000:1 odds of hitting the jackpot); in response to the player choosing the side-wager option, providing the player with a second probability of achieving the special-payout outcome, the second probability being greater than the first probability (9: 6-27, as the side wagers increase, the odds of hitting the jackpot increase); conducting the basic game with the first probability or the second probability, depending on the player's choice on the side-wager option (10: 20-29, the player plays the base game, before a special triggering event has occurred) ; and in response to conducting, crediting the player the special payout when the special-payout outcome occurs in the basic game (10: 30-55, the predetermined combination 7-7-7 triggers the special-payout outcome of a jackpot win).

Re Claims 4 and 31,

Baerlocher discloses a method and gaming terminal wherein the special payout is a bonus game (8: 18-45, a predetermined combination on the reels of the primary game triggers a bonus game)

Re Claims 5, 7, 32, and 34,

Baerlocher discloses a method and gaming terminal wherein the plurality of randomly selected outcomes are indicated by a plurality of symbols in the reel game of a slot machine (7: 35-38).

Re Claims 9 and 36,

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Baerlocher teaches a method and gaming terminal, wherein providing the player with a second probability of achieving the special-payout outcome comprises modifying the method the wagering game uses to read the plurality of symbols (9: 1-27, the gaming machine modifies the odds of the predetermined jackpot symbols, disclosed as 7-7-7 in 10: 30-40, occurring)

Re Claim 25,

Baerlocher discloses a gaming terminal for playing a wagering game (6: 52-54), comprising: a basic game having a plurality of symbols that indicate a randomly selected outcome of the basic game (6:52-54 and Fig. 1B, slot reels **34**), the basic game also having a plurality of paylines (1: 44-55) and a maximum wager on each of the plurality of paylines (1:44-55); a progressive payout having a first payout (1: 30-43, 9:61-67, 10:1-15); and an input device for allowing a player to become eligible for the progressive payout (7: 4-7 and 56-58, the "bet one" button); wherein the gaming terminal presents the player with two independent options to be eligible for the progressive payout including (i) the player activating the input device (7: 4-7, pressing the bet one button repeatedly to increase the wager until it reaches the maximum bet) and (ii) the player choosing to play all of the paylines and placing the maximum wager on each of the plurality of paylines (the player selecting "max bet" outright, 1: 44-45); wherein, in response to one of the two options being chosen, the gaming terminal awards the player the first payout when a first randomly selected outcome is achieved (1: 55-67).

Re Claims 2 and 26-27,

Baerlocher discloses a gaming terminal, wherein in response to the input device being activated, the gaming terminal awards the player a second and third payout when a second or third randomly selected outcome is achieved (6: 52-56, it is disclosed that the primary game can be slots, which it is extremely well-known will have a pay-table with a plurality of different awards based on different combinations that appear on the stopped reels).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 3, 6, 17, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,155,925 to Giobbi et al. (Giobbi), in view of OFFICIAL NOTICE.**

Re Claims 3 and 30

Giobbi discloses all of the limitations of parent claims 1 and 30, as discussed in the rejections of the claims above. Giobbi lacks the special payout being a progressive payout. The notion of a special or bonus payout being a progressive payout is very old and well-known in the art of casino gaming. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have replaced Giobbi's fixed-value bonus payouts with progressive payouts, because it is well-known in the art

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that the potential for winning a very large jackpot, with a small wager, makes progressive gaming attractive to many players.

Re Claims 6, 17, and 33,

Giobbi discloses all of the limitations of parent claims 5, 16 and 32, as discussed in the rejections of the claims above. Giobbi lacks the plurality of symbols being a card from a deck of playing cards. It is very well-known in the art that slot reels can bear any type of character.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have replaced the pictorial slot reel symbols of Giobbi with playing card symbols, in order to attract players who enjoy gambling games with a card-playing theme.

6. Claims 8, 10-11, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 7,029,395 to Baerlocher, in view of US 2004/0242315 to US 2004/0166918 to Walker et al. (Walker).

Re Claims 8, 11, and 35,

Baerlocher discloses all of the limitations of parent claims 5 and 34, as discussed in the rejections of the claims above. Baerlocher discloses in Column 9, that the odds of winning a jackpot on a conventional slot machine can be varied from a nonzero probability with a minimum wager, to a higher probability with increasing wagers.

However, Baerlocher does not specifically disclose how these odds of hitting a predetermined jackpot pattern on the reels are varied.

Walker discloses a method and apparatus for changing the parameters of a casino slot machine during game play (Abstract). Walker teaches providing changing the probability of achieving a payout outcome comprising changing the number of winning symbols in the plurality of symbols (Walker Paragraph 24 defines the term "game play parameter" as including the number of symbols on a specific reel, and the probability of the character appearing on a given handle pull". In Paragraphs 103-104, Walker discloses that the gaming device **104** or the casino can vary the game play parameters during play, to control the number of bonus symbols on each reel which initiate a bonus round).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's teaching of the gaming machine varying the number of winning symbols on the reels during game play, into the disclosed art of Baerlocher, in order to implement Baerlocher's disclosed method of changing the probability of a player achieving the jackpot-triggering symbols on the reels as a function of the player's wager.

Re Claim 10,

Baerlocher in view of Walker further teach a method for playing a wagering game on a gaming terminal, the wagering game having a progressive payout (progressive jackpot, 1: 30-43, 9:61-67, 10:1-15), the method comprising: presenting a basic game having a plurality of randomly selected outcomes including a progressive-payout outcome (6: 52-56, it is disclosed that the primary game can be slots, and 1: 30-43, 8:

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48-67 disclose a jackpot award, which is the special-payout outcome, and 9:61-67, 10:1-15 further disclose that the jackpot payout can be a progressive jackpot payout); presenting a side-wager option for a player (7:4-10, each time the player increments the wager beyond the minimum wager, the player is making a side-wager); presenting a first spinning reel (each of the reels 34 in Fig. 1), the first spinning reel providing the player with a first probability greater than zero of achieving the progressive-payout outcome (9:1-5, 100,000:1 odds of hitting the jackpot); presenting a second spinning reel, the second spinning reel providing the player with a second probability of achieving the progressive-payout outcome, the second probability being greater than the first probability; and in response to the player selecting the side-wager option, substituting the second spinning reel for the first spinning reel, increasing the player's probability of winning the progressive payout (Walker Paragraphs 24, 103, and 104, as discussed in the rejection above, Walker teaches modifying a reel during the course of game play, by changing the number of bonus triggering symbols on it. Therefore a second reel is a first reel that has had the symbols modified).

7. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,155,925 to Giobbi et al. (Giobbi), in view of US 2003/0064807 to Walker et al. (Walker).

Re Claim 19,

Giobbi discloses each of the gaming terminals having the two options for being eligible for the special payout (see the rejection of claim 12 above), the gaming terminals further comprising signage located above and coupled to the gaming

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terminals (Fig. 1, a set-top box display screen **20**), the signage displaying the special payout and for receiving a signal from one of the gaming terminals that the gaming terminal is eligible to win a special payout (4: 21-38, the display screen **20** is a video display screen, which is capable of displaying any necessary output related to the game, as is very well-known in the art, and this video display screen displays the bonus game, which includes a bonus payout as discussed in the rejection of claim 12 above).

However, Giobbi lacks the gaming machine **10** being in combination with at least one other gaming terminal for conducting wagering games, the gaming terminals and the signage being a gaming system.

Walker discloses an analogous system comprising networked casino gaming devices for playing games of chance including slot games and card games (Abstract and Paragraph 42). Walker teaches the plurality of casino gaming machines (Fig. 1A, gaming devices **104**, **106**, **108**) being in combination with at least one other gaming terminal (Fig. 1A, the gaming devices are networked) for conducting wagering games (Paragraph 42), the gaming terminals and the signage being a gaming system (each of the gaming devices (Fig. 1A and Paragraphs 30-32, a system for linked game play wherein players can compete as a group or against each other, and Paragraph 50, wherein each of the gaming devices has one or more video output devices).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated Walker's teaching of a single gaming machine being used in a network in order to interact with other gaming machines, into the disclosure of Giobbi, because networked game play is old and well-known in the art,

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and also because many gamblers enjoy the social interaction that linked gaming provides (Walker, Paragraph 16).

Re Claims 20-21,

Giobbi in view of Walker further teaches a gaming system wherein the signage includes a signage controller for controlling an outcome of the special payout on one of the gaming terminals, and a gaming terminal controller (Giobbi 4: 21-38, Fig. 2, the video display **20** is controlled by the processor **26**, which also controls all other functions of the game, also Walker paragraph 68, each gaming device has a processor that allows it to communicate with other machines).

Re Claim 22,

Giobbi in view of Walker further teaches a gaming system, wherein each of the plurality of gaming terminals are identical machines (Walker Paragraph 42, the gaming machines can be any gaming machine, including slots, poker, etc. Because each gaming machine can be any of the disclosed gaming machines, the system is inherently capable of supporting all of the machines being the same machine).

Re Claim 23,

Giobbi in view of Walker discloses all of the limitations of parent claim 19, as discussed in the rejection of the claim above. However, Giobbi in view of Walker lacks the special payout being a progressive payout.

Walker further discloses a networked wagering game, having a progressive bonus payout (Paragraph 89).

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It would have been further obvious to one of ordinary skill in the art, at the time the invention was made, to have incorporated the special progressive payout of Walker, into the disclosure of Giobbi, because it is well-known in the art for slot machines to have progressive special payouts, because players are often attracted to progressive gaming due to the potential for a high payout based on a small wager.

Re Claim 24,

Giobbi in view of Walker further teaches the gaming system of claim 19, wherein the first payout is a bonus game payout (Giobbi Figs. 8a-e disclose a plurality of bonus game payouts).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, and has been included in the attached Notices of References Cited.

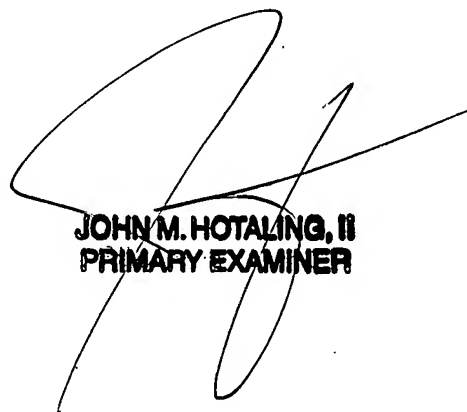
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Hylinski whose telephone number is 571-270-1995. The examiner can normally be reached on M-Thurs. 7:00a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/SJH/ 09/26/2007



JOHN M. HOTALING, II
PRIMARY EXAMINER